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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/663,255

09/16/2003

Joseph L. Kennedy

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29493

7590

09/29/2006

HUSCH & EPPENBERGER, LLC
190 CARONDELET PLAZA
SUITE 600
ST. LOUIS, MO 63105-3441

EXAMINER

DESIR, JEAN WICEL

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 09/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/663,255

Applicant(s)

KENNEDY, JOSEPH L.

Examiner

Jean W. Désir

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/10/06 (Amendment).
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 31 and 32 is/are allowed.
6) ☒ Claim(s) 1-30, 33 and 34 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 16 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because the reference numbers mentioned in the description page 6 first two paragraphs do not correspond to the reference numbers in Fig. 1 of the drawings. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Note: *No response has been presented to this objection of the drawings already presented to the Applicant in the first Office Action.*

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-30, 33, 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al (US 6,351,289) in view of Gadre et al (US 5,995,161).

Claim 1:

Chen discloses:

“sizing a Vertical Blanking Interval area in an On Screen Display memory;
locating a Vertical Blanking Interval area in an On Screen Display memory”, see Fig. 2 item 24, col. 5 line 52 to col. 6 line 8, col. 6 lines 45-50;

“generating a Vertical Blanking Interval luma waveform bitmap”, see Fig. 7, col. 7 lines 22-24, 66-67;

“and overlaying said Vertical Blanking Interval luma waveform bitmap in a digital video signal according to the gray scale palette, size and location data stored in the On Screen Display memory”, see Fig. 2 item 26, col. 5 lines 17-27;

the difference between the claimed invention and Chen's disclosure is that Chen does not explicitly “create a gray scale palette in an On Screen Display memory” as claimed. However, the structure of the claimed invention is a notoriously well known technique in the art, as evidence see Gadre at col. 6 lines 38-44, col. 10 lines 9-17, used to add detail to images; an artisan would be motivated to modify Chen in view of Gadre and implement this existing technique to arrive at the claimed invention, because this technique is readily available to the designer and advantageously would enhance the appearance of images. Therefore, the claimed invention would have been obvious to a person of ordinary skill in the art at the time the invention was made.

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Claim 2 is disclosed, see Gadre at col. 6 lines 38-44.

Claims 3, 4 are disclosed, see Chen at col. 5 line 52 to col. 6 line 8.

Claim 5 is disclosed, see Chen at col. 3 lines 41-44.

Claim 6 is disclosed, see Chen at col. 5 lines 17-27, Fig. 2 item 26.

Claim 7 is disclosed, see Gadre at col. 3 line 42.

Claim 8 is rejected for the same reasons as claim 1, because Gadre teaches On Screen Display controller (see Gadre at col. 10 lines 6-17).

Claim 9 is disclosed, see Gadre at col. 6 lines 38-44.

Claims 10, 11 are disclosed, see Chen at col. 5 line 52 to col. 6 line 8.

Claim 12 is disclosed, see Chen at col. 5 lines 17-27, Fig. 2 item 26.

Claim 13 is disclosed, see Gadre at col. 3 line 42.

Claims 14-16 are rejected for the same reasons as claims 9-11.

Claims 17, 18 are disclosed, see Chen at col. 5 line 52 to col. 6 line 30.

Claim 19 is disclosed, see Gadre at col. 5 line 62 to col. 6 line 12, Chen at col. 3 line 60 to col. 4 line 7.

Claim 20 is disclosed, see Gadre at Fig. 1 item 20, col. 10 lines 6-17.

Claims 21-23 are disclosed, see Chen at Fig. 2 item 24, col. 4 lines 3-16, Gadre at col. 10 lines 6-17.

Claim 24 is disclosed, see Chen at col. 5 line 52 to col. 6 line 30, Gadre at Fig. 3 items 98, 94.

Claim 25 is disclosed, see Gadre at col. 5 line 62 to col. 6 line 12, Chen at col. 3 line 60 to col. 4 line 7.

Claim 26: the claimed limitation “wherein said grayscale palette allocates eight bytes per pixel” is not explicitly disclosed by the above implementation, because Gadre does not say the size of the grayscale palette (eight bytes per pixel as claimed); however, the claimed structure is at level of an artisan, because the number of shades of the grayscale would depend on the number of bits per pixel, i.e. the size of the grayscale palette, and different grayscale palette sizes would be used depending on the applications; Therefore, the claimed invention would have been obvious to a person of ordinary skill in the art at the time the invention was made.

Claim 27 is disclosed, see Gadre at Fig. 1 item 38.

Claims 28, 29 are disclosed, see Chen at col. 3 line 60 to col. 4 line 16, col. 5 line 52 to col. 6 line 30.

Claim 30 is disclosed, see Gadre at col. 6 lines 40-57.

Claim 33 is rejected for the same reasons as claim 1.

Claim 34 is rejected for the same reasons as claim 8.

Response to Arguments

4. Applicant's arguments have been fully considered but they are not persuasive.

The Applicant argues on page 9 of the REMARKS that “... These pending claims cannot be obvious without the required suggestion or motivation of the combination in at least one of the prior art references.” These arguments are not persuasive; the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is

some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, difference between the claimed invention and Chen's disclosure has been clearly pointed out in the rejection, and it is also shown in the rejection that "create a gray scale palette in an On Screen Display memory" is a knowledge available to one of ordinary skill in the art at the time the invention was made and used to add detail to video images; therefore, motivation or suggestion to modify the reference has been clearly provided, no impermissible hindsight has been used.

Allowable Subject Matter

5. Claims 31, 32 are allowed.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any


extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean W. Désir whose telephone number is (571) 272 7344. The examiner can normally be reached on 5/4/9 - First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David L. Ometz can be reached on (571) 272 7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JWD
Sep. 27, 06



DAVID OMETZ
SUPERVISORY PATENT EXAMINER